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10/015,323	12/13/2001	Randal D. Schafer	840070.404	2929

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EXAMINER

GONZALEZ, MADELINE

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/015,323

Applicant(s)

SCHAFER, RANDAL D.

Examiner

Madeline Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

In response to applicant's amendment dated May 29, 2003

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 11-15 and 17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Pederson (U.S. 3,171,888) in view of Szabo (U.S. 2,522,908).

Pederson discloses a ruler, as shown in Fig. 1, having:

- a sheet of rigid material having a plurality of lines *B* formed on a first side thereof;
- and
- a roughened surface *C* on a second side to provide a non-slip surface when placed against a surface.

Pederson lacks a flexible sheet, the specific material of the rigid and the flexible sheets, the specific location of the flexible sheet, the specific means by which the flexible sheet is

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adhered to the rigid sheet, the flexible sheet being removably adhered to the rigid sheet, the flexible sheet having a plurality of segments, and the specific location of the lines.

With respect to the flexible sheet: Szabo discloses a ruler having a sheet of rigid material 12 and including a plurality of lines 15 formed on a first side, and a sheet of flexible and non-slipping material 17 on a second side to prevent the ruler from sliding on the work. The sheet of flexible and non-slipping material 17 is formed of rubber or similar material, which is, in a broad sense, a non-static cling material. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the ruler disclosed by Pederson with a sheet of non-static cling, flexible and non-slipping material as taught by Szabo, instead of the roughened surface, since they are alternate types of surfaces which will perform the same function, if one is replaced with the other, of preventing the ruler from sliding on the work.

With respect to the specific material of the rigid and the flexible sheets: Pederson as modified by Szabo disclosed a ruler having a sheet of rigid material on a first side and a sheet of flexible material on a second side. The particular type of material used to make the rigid sheet and the flexible sheet claimed by applicant, i.e., transparent sheet of rigid material; and transparent sheet of non-static cling, flexible material, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use

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of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the rigid sheet and the flexible sheet of a transparent material in order to be able to see through the ruler and since is well known in the art the use transparent rulers.

With respect to the specific location of the flexible sheet, and the specific location of the lines: Pederson as modified by Szabo disclosed a ruler having a sheet of rigid material having a plurality of lines formed on a first side, and a sheet of flexible material covering the entire of a second side. Changing the location of the flexible sheet from the location shown by Pederson as modified by Szabo to a location on first side of the ruler, and changing the location of the lines from the location shown by Pederson as modified by Szabo to a location on a second side of the sheet of rigid material; or to a location on the second side of the flexible material, absent any criticality, is only considered to be an obvious modification of the ruler disclosed by Pederson as modified by Szabo that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position if the operation of the device would not be thereby modified. See In re Japikse, 86 USPQ 70 (CCPA 1950). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to change the location of the flexible sheet and change the location of the lines in order to provide alternate embodiments of the invention without changing the operation of the invention.

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With respect to the specific means by which the flexible sheet is adhered to the rigid sheet: Pederson as modified by Szabo disclosed a ruler having a flexible sheet adhered to a rigid sheet. The specific means by which the flexible sheet is adhered to the rigid sheet claimed by applicant, i.e., with surface adhesion, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the flexible sheet is adhered to the rigid sheet, as already suggested by Pederson as modified by Szabo, and 2) the use of the particular type of adhesion means by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of adhesion means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to adhere the flexible sheet to the rigid sheet as already suggested by Pederson as modified by Szabo.

With respect to the flexible sheet being removably adhered to the rigid sheet: Pederson as modified by Szabo disclosed a ruler including a sheet of rigid material and a sheet of flexible material being adhered to the sheet of rigid material. The term "removably" does not structurally distinguish the claimed invention from Pederson as modified by Szabo. Furthermore, in a broad sense, any structure may be considered to be "removably", if so desired as long as the structure may be removed by any means, if so desired.

With respect to the flexible sheet having a plurality of segments: Pederson as modified by Szabo disclosed a ruler having a sheet of rigid material including a plurality of lines formed on a

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first side and a sheet of flexible material formed on a second side. It has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See St. Regis Paper Co. v. Bemis Co., 193 USPQ 8. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide lines on the sheet of flexible material in order to make more accurate measurements and avoid any visual distortion that may result from the addition of the sheet of flexible material.

3. Claims 7-10, 15, 16, 18 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over McCutchen et al. (U.S. 5,105,551) [hereinafter McCutchen].

McCutchen discloses a tool, as shown in Fig. 1, having:

- a sheet of rigid material 16 having opposing first and second sides with a plurality of lines formed on one of the first and second sides;
- a sheet of flexible material 10 having opposing first and second sides with a plurality of lines formed on one of the first and second sides, said sheet of flexible material 10 is adhered to only one of the first and second sides of the sheet of rigid material 16 and sized and shaped to substantially cover the side to which it is adhered and to provide a non-slip surface when placed against a surface;
- wherein the sheet of flexible material 10 is placed against the side of the sheet of rigid material 16 on which the plurality of lines are formed; and

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- wherein the sheet of flexible material 10 can be formed of multiple segments 60, 61, as shown in Fig. 4, said segments being formed of a material, such as rubber which can be considered a non-static cling material.

McCutchen lacks the specific material of the rigid and of the flexible sheets, the flexible sheet being removably adhered to the rigid sheet, and the method steps.

With respect to the specific material of the rigid and of the flexible sheets: McCutchen discloses a tool including a sheet of rigid material 16 and a sheet of flexible material 10 being adhered to the sheet of rigid material 16. The particular type of material used to make the rigid sheet and the flexible sheet claimed by applicant, i.e., transparent sheet of rigid material; and transparent sheet of non-static cling, flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the rigid sheet and the flexible sheet transparent in order to be able to see through the tool and use it more accurately.



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With respect to the flexible sheet being removably adhered to the rigid sheet: McCutchen discloses a tool including a sheet of rigid material 16 and a sheet of flexible material 10 being adhered to the sheet of rigid material 16. The term “removably” does not structurally distinguish the claimed invention from McCutchen. Furthermore, in a broad sense, any structure may be considered to be “removably”, if so desired as long as the structure may be removed by any means, if so desired.

With respect to the method steps: The method steps are met during the normal fabrication of the tool stated above.

#### ***Response to Arguments***

4. Applicant's arguments filed on May 29, 2003 have been fully considered but they are not persuasive.

5. In response to applicant's argument that the combination of Pederson and Szabo lacks transparency and the use of non-static cling, flexible material: Pederson as modified by Szabo discloses a ruler/tool for use in measuring and marking material having a sheet of rigid material and a sheet of flexible material covering an entire side of the sheet of rigid material, said sheet of flexible material is formed of rubber, which can be considered a non-static cling material. It would have been obvious to a person having ordinary skill in the art at the time the invention was

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made to make the rigid sheet and the flexible sheet of a transparent material in order to be able to see through the ruler and since is well known in the art the use of transparent materials in rulers.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the lines creating a gridwork over substantially the entire surface of the tool) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. In response to applicant's argument regarding McCutchen: McCutchen discloses a tool having a sheet of rigid material and a sheet of flexible material made of rubber, which can be considered a non-static cling material. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the rigid sheet and the flexible sheet transparent in order to be able to see through the tool and use it more accurately.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (703) 308-7004. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MG  
August 22, 2003



Diego F.F. Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800